

Applicant: Steven P. Adams et al.
Title: CELL ADHESION INHIBITORS
Application No.: 10/625,626
Filing Date: July 24, 2003

Attorney Docket No.: 14937.0003.D2
Examiner: Janet L. Coppins
Art unit: 1625
Page 7 of 8

REMARKS

Claims 1, 9, 11, and 12 have been amended to more clearly describe the compound of formula (I). Support for the amendments can be found, for example, at page 11, lines 17-20, and at page 16, lines 23-24 of the specification. Claim 8 has been cancelled. No new matter has been added. The Examiner has allowed claims 1-7, 10 and 11 over the prior art.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 12-15 have been rejected by the Examiner under 35 U.S.C. § 112, first paragraph, for lack of enablement. Specifically, the Examiner contends that the specification does not “reasonably provide enablement for an agent which prevents [cell adhesion-associated] diseases through the use of the composition.” See the Office Action at page 2. Claim 12 is independent, and claims 13-15 depend from it.

Independent claim 12 is directed to a method of preventing, inhibiting or suppressing cell adhesion in a mammal that includes the step of administering to said mammal a pharmaceutical composition comprising an effective amount of a cell adhesion inhibitory compound of formula (I). The method is **not** directed to a method of preventing a disease; rather, it is directed to a method of preventing, inhibiting, or suppressing cell adhesion in a mammal. The Examiner has indicated that the rejection can be overcome by “including the phrase ‘in need thereof’ after ‘in a mammal’ in line 2 of claim 12.” See the Office Action at page 3. Although Applicants believe the claims are enabled, claim 12 has been amended accordingly in the interest of advancing prosecution. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, second paragraph and claim objections

The Examiner has rejected claim 8 under 35 U.S.C. § 112, second paragraph, for indefiniteness. Specifically, the Examiner states that the definition of Y in claim 8 (which depends from claim 1) “Y is -CO-, -CH₂- or -SO₂-,” lacks antecedent basis for the groups -CH₂- and -SO₂-. See page 4 of the Office Action. The Examiner has objected to claim 9 on the grounds that if claim 8 is amended to “delete the rejected moieties from the Y variable, then claim 9 will be reciting the same subject matter as claim 8.” See page 4 of the Office Action.

Applicants have amended claim 1 so as to define Y as -CO-, -CH₂- or -SO₂-. See independent claim 1. Support for the amendment can be found in claim 8 as originally filed, and

Applicant: Steven P. Adams et al.
Title: CELL ADHESION INHIBITORS
Application No.: 10/625,626
Filing Date: July 24, 2003

Attorney Docket No.: 14937.0003 D2
Examiner: Janet L. Coppins
Art unit: 1625
Page 8 of 8


at page 16, lines 23-24 of the specification. Claim 8 has been cancelled, and claim 9 has been amended to depend from claim 1. Applicants believe the amendments put claims 9 in condition for allowance, and ask that the Examiner withdraw any objection to claim 9.

CONCLUSION

Applicants ask that all claims be allowed. Please apply any deposits or credits to Deposit Account No. 19-4293.

Respectfully submitted,

Date: 5-12-04


Harold H. Fox
Reg. No. 41,498

Steptoe & Johnson LLP
1330 Connecticut Avenue, NW
Washington, DC 20036-1795
Phone: 202-429-3000
Fax: 202-429-3902